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09/934,479	08/23/2001	Yoko Fujiwara	018656-241	8426

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EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/934,479

Applicant(s)

FUJIWARA ET AL.

Examiner

Jeffery A. Brier

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-34,37-40 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-34, 37-40, and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 11/02/2007 to the claims and the amendment filed on 07/27/2007 to the title have been entered. The amendments to the claims overcomes the 112 and 101 issues raised in the previous office rejection, however, the claim amendments do enter new 112 issues which are discussed below.

Response to Arguments

2. Applicant's arguments filed 07/27/2007 have been fully considered and in view of the claim amendments they are persuasive to overcome the 112 and 101 issues raised in the previous office rejection.

Specification

3. The disclosure is objected to because of the following informalities:
page 19 lines 13-25 lack a reference to figure 12(B).
Appropriate correction is required.

Claim Objections

4. Dependent claims 12, 14-16, 22, 23, 29, and 38 are objected to because of the following informalities: the preamble refers to a program while the parent claim is a computer readable medium claim. Note dependent claim 43 correctly refers to parent claim 9 as a computer readable medium claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-9, 11-34, 37-40, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 3, 5, 9, 11, 13, 17, 27, 32, and 33:

Independent claims 1, 3, 5, and 17 were amended with similar means plus function language (means for detecting a user selection of a plurality of document blocks that is marked on a scanned document (claims 1 and 17) or means for detecting a user selection of a document block that is marked on a scanned document (claims 3 and 5)). Independent claims 9, 11, and 13 were amended with similar function language (detect a user selection of a plurality of document blocks that is marked on a scanned document (claim 9) or detect a user selection of a document block that is marked on a scanned document (claims 11 and 13)). Independent claim 27 was amended with similar circuit plus function language (a detection circuit for detecting a user selection of a plurality of document blocks that is marked on a scanned document). Independent claims 32 and 33 were amended with similar function language (detecting a user selection of a plurality of document blocks that is marked on a scanned document). These amendments to the independent claims renders these claims and their dependent claims unclear since, taking claim 1 as an example, these claims do not clearly claim whether the document block(s) are marked by the user or they are just

marked. The prior art document's blocks are marked such that the system and process will recognize document blocks in the entire scanned document and for example Kurosawa allows the user to select a document block or plurality of document blocks of the entire scanned document.

Claim 4:

At line 4 "the at least one reconstructed block" lacks antecedent basis in the claim.

Claim 5:

At line 14 "the at least one document block" lacks antecedent basis in the claim.

Claim 8:

At line 3 "the image data" lacks antecedent basis in the claim.

Claim 11:

At lines 16 and 17 "the at least one reconstructed block" lacks antecedent basis in the claim.

At line 18 "the specific image" lacks antecedent basis in the claim, see the amendment made to claim 3 at line 20.

Claim 12:

At line 2 "the image processing" lacks antecedent basis in the claim.

At lines 3 and 4 "the at least one reconstructed block" lacks antecedent basis in the claim.

Claim 13:

At line 14 "the at least one document block" lacks antecedent basis in the claim.

Claim 14:

At line 2 "the image processing" lacks antecedent basis in the claim.

Claim 15:

At line 2 "the image processing" lacks antecedent basis in the claim.

Claim 16:

At line 2 "the image processing" lacks antecedent basis in the claim.

At line 3 "the image data" lacks antecedent basis in the claim since in claim 9 document data and background data as well as digital image data is claimed with regard to the "plurality of document blocks".

Claim 17:

At lines 2 and 3 a means plus function clause was added to this method claim and line 2 refers to "the steps". Since a "means" is not a step this means plus function clause is unclear added into this method claim.

At lines 20-22 the wherein clause is unclear since earlier in the claim similar language was added to the claim, thus, the metes and bounds of the claim are unclear in view of the wherein clause and previous lines of this claim.

Claim 18:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At line 3 "the entire image" lacks antecedent basis in the claim.

Claim 19:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At line 3 "the entire image" lacks antecedent basis in the claim.

Claim 20:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

Claim 21:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At line 3 "the entire image" lacks antecedent basis in the claim.

Claim 22:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At lines 2 and 3 "the entire image" lacks antecedent basis in the claim.

Claim 23:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

Claim 24:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At line 3 "the entire image" lacks antecedent basis in the claim.

Claim 25:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

At line 3 "the entire image" lacks antecedent basis in the claim.

Claim 26:

At line 2 "the extracted at least one document block" lacks antecedent basis in the claim.

Claims 28-31:

For each claim:

At line 2 "the reconstructed at least one document block" lacks antecedent basis in the claim.

At line 3 "the extracted at least one document block" lacks antecedent basis in the claim.

Claim 33:

Lines 3-4 and 12-14 conflict with each other since it is not clear if the user selection at lines 3-4 and the perimeter are the same and if they are being established by the user beforehand at lines 12-14.

Claim 34:

This dependent claim of claim 33 has the same conflicting issue.

Claims 37-40:

For each claim:

At line 2 "the entire image" lacks antecedent basis in the claim. (lines 1 and 2 of claim 38)

At line 3 "the at least one document block" lacks antecedent basis in the claim. (lines 2 and 3 of claim 38.

7. A proper prior art analysis of the claims cannot be made because the metes and bounds of the claims are not definite and because the specification does not clarify the claims. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions). However, if the independent claims were amended to clearly claim the user marks the scanned document prior to scanning then Kurosawa's teaching of the user marking the document after scanning will be overcome in a 35 USC 102 sense, however, the Examiner will need to reconsider such an amendment under 35 USC 103 in view of KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007), U.S. Supreme Court No. 04-1350 Decided April 30, 2007, 127 SCt 1727, 167 LEd2d 705.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628